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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/029,861 | 12/31/2001 | Akimasa Ohta | Q67827 | 4020 |
| 7590 | 03/18/2005 | | EXAMINER | |
| SUGHRUE, MION, ZINN, MACPEAK & SEAS 2100 Pennsylvania Avenue, N. W. Washington, DC 20037-3202 | | | PARTON, KEVIN S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2153 | |

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/029,861 | OHTA ET AL. | |
| | Examiner | Art Unit | |
| | Kevin Parton | 2153 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 December 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/31</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 9, lines 9-11, the limitation is detailed for comparing a copy of the mail from the sender information terminal with the copy of the mail from the sender information terminal. In the specification, the only comparison described is between a mail from a sender information terminal and a reply mail from the receiving terminal.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-5, and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Cairo (USPN 5,815,555).
5. Regarding claims 1 and 5, Cairo (USPN 5,815,555) teaches an electronic mail certifying system comprising:

- a. A server of a content certifying provider for certifying a content of an electronic mail (figure 6, controller 82).
- b. A sender information terminal which when a transmission mail needing the content certifying transmitted to a transmission destination, transmits a copy of the transmission mail to the server of the content certifying provider (figure 3, element 52; column 6, lines 37-40, 49-52).
- c. A receiver information terminal which when the transmission mail needing the content certifying received from the sender information terminal, transmits a reply mail corresponding to the transmission mail to the sender information terminal, and transmits a copy of the reply mail to the server of the content certifying provider (column 6, lines 53-55; column 7, lines 1-9).
- d. Wherein the server of content certifying provider compares the copy of the transmission mail from the sender information terminal with the copy of the reply mail from the receiver information terminal, and then transmits that compared result to the sender information terminal and the receiver information terminal (column 7, lines 1-20).

6. Regarding claims 3 and 7, Cairo (USPN 5,815,555) teaches all the limitations as applied to claims 1 and 5, respectively. He further teaches means wherein the server of the content certifying provider stores the copy of the transmission mail from the sender information terminal and the copy of the reply mail from the receiver information terminal, respectively (column 6, lines 37-40).

7. Regarding claims 4 and 8, Cairo (USPN 5,815,555) teaches all the limitations as applied to claims 1 and 5, respectively. He further teaches means wherein the server of the content certifying provider certifies at least transmission destinations, dates, and contents of the electronic mails mutually transmitted from the sender information terminal and the receiver information, in a usage of an on-line business or an online shopping (column 7, lines 16-20).

8. Regarding claims 9 and 10, Cairo (USPN 5,815,555) teaches a system for carrying out a content certification of an electronic mail with means for:

- a. Receiving a copy of a transmission mail needing the content certification from a sender information terminal (figure 3, element 52; column 6, lines 37-40, 49-52).
- b. Receiving a copy of the reply mail corresponding to the transmission mail from a receiver information terminal (column 6, lines 53-55; column 7, lines 1-9).
- c. Comparing the copy of the transmission mail from the sender information terminal with the copy of the reply mail from the receiver information terminal (column 7, lines 1-20).
- d. Transmitting that compared result to the sender information terminal and the receiver information terminal (column 7, lines 1-20).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2153

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cairo (USPN 5,815,555) in view of Srinivasan (USPN 6,717,936).

11. Regarding claims 2 and 6, although the system disclosed by Cairo (USPN 5,815,555) (as applied to claims 1 and 5) shows substantial features of the claimed invention, it fails to disclose means wherein the server of the content certifying provider performs a charging operation on at least one of the sender information terminal and the receiver information terminal at a time of a usage of the content certification.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Cairo (USPN 5,815,555) as evidenced by Srinivasan (USPN 6,717,936).

In an analogous art, Srinivasan (USPN 6,717,936) discloses a system for delivering email wherein the server of the content certifying provider performs a charging operation on at least one of the sender information terminal and the receiver information terminal at a time of a usage of the content certification (column 7, line 51 – column 8, line 3).

Given the teaching of Srinivasan (USPN 6,717,936), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Cairo (USPN 5,815,555) by charging a customer for the certification of content. This benefits the system, by allowing the certification system to

be reimbursed for the processor time and network bandwidth required in the certification of messages.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see the following:

- a. Wang et al. (USPN 6,314,454)
- b. Tang (USPN 6,185,682)
- c. Zabetian (USPN 6,327656)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Parton whose telephone number is (571)272-3958. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin Parton



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